

REMARKS

In the Office Action mailed April 11, 2008 from the United States Patent and Trademark Office, claim 7 was objected to as containing informalities, claims 1-9 and 12-15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,999,707 to Taniguchi et al. (hereinafter “Taniguchi”) in view of allegedly admitted prior art and U.S. Patent No. 5,580,177 to Gase et al. (hereinafter “Gase”), claims 10 and 16-19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Taniguchi, allegedly admitted prior art, and Gase, and further in view of allegedly well-known prior art, claims 20, 21, 24-28, and 31-34 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Taniguchi in view of Gase, and claims 22, 29, and 35 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Taniguchi and Gase in view of allegedly well-known prior art.

Applicant respectfully provides the following:

Claims 1-5, 7-8, 10-11, 13, 16-18, 24-30, and 32 are currently amended. Claims 20-23 are canceled. Claims 36-38 are new.

Claim Objection:

In the Office Action, claim 7 was objected to because of informalities. Claim 7 has been amended as suggested in the Office Action, and Applicant respectfully requests withdrawal of the objection.

Rejections under 35 U.S.C. § 103(a):

In the Office Action, claims 1-35 were rejected under 35 U.S.C. § 103(a) as being unpatentable over at least Taniguchi and Gase, with several of the claims being rejected over

combinations further including allegedly well-known prior art and allegedly admitted prior art. M.P.E.P. § 2141 sets forth the *Graham* factual enquiries that should be considered when making an obviousness rejection under Section 103: 1) ascertaining the scope and content of the prior art; 2) ascertaining the differences between the claimed invention and the prior art; and 3) resolving the level of ordinary skill in the pertinent art. (Citing *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966).)

For a rejection under Section 103 to stand, it must explicitly set forth 1) factual findings showing that each claim element was known in the art at the time of the invention, and 2) factual findings showing that one of ordinary skill in the art, at the time of the invention, would have found it obvious to modify or combine the teachings to arrive at the claimed invention. (See, for example, the enumerated required articulations set forth in M.P.E.P. § 2143 for each lettered rationale.) Applicant respectfully submits that the references in the Office Action, either alone or in combination, do not teach or suggest all the limitations claimed in the claim set provided herein.

The independent claims have been rewritten to include limitations not taught by the art of record. Applicant respectfully notes that similar limitations originally contained in the dependent claims have been rejected in part based on Official Notice of allegedly well-known prior art, and therefore provides the following.

Reliance on Allegedly Well-Known Prior Art:

In the Office Action, Official Notice was taken that “it is well known and obvious to a person of ordinary skill in the art” 1) for a print job to be converted into a format compatible with the printer, 2) for a print job to emulate capabilities incompatible with the printing device, and 3) for a print job to emulate capabilities incompatible with the printing device including one

of copy collation, booklet printing, and N-up printing, among other assertions of allegedly well-known prior art. Applicant respectfully and explicitly traverses each of the above findings as they are applied to the claims.

As a preliminary item, it is noted that the M.P.E.P. indicates that Official Notice of the type relied on in the Office Action should only rarely be taken, and should only be taken when the fact asserted is capable of “instant and unquestionable demonstration as being well-known.” See M.P.E.P. 2144.03.

Each of the claims provided in the claim set herein is related to displaying print job information for selection on a front panel of a printer prior to despooling the print jobs to the printer. Thus, the claimed invention is directed to a system where a print job is selected by and pulled to a printer or other printing device. Such an arrangement is very different from the common printing situation, where a user prints from a computer utilizing a printer driver that is customized for a selected printer. In the claimed systems, as clearly outlined in the specification (see page 5 lines 3-5), print jobs are not despoiled to a selected printing device in advance, but are preserved on a client computer device or a print server, and are then despoiled to the printing device after a request to do so has been received from the printing device.

Thus, whether or not the facts discussed in the multitude of Official Notices are true, it has not been shown that the recited limitations were well known as it relates to pulled print jobs where the initial printing has already occurred and the use of a client-side printer driver has been previously completed. Applicant respectfully submits that it was not well known in the art at the time of the invention to convert a print job into a format compatible with the printing device after receiving a request at the printing device to despool the print job to the printing device, as is recited in claim 1. Applicant further respectfully submits that it was not well known in the art at

the time of the invention to convert a print job into a printer-dependent format specific to a printing device that received a selection to print the print job, as is recited in claim 24. Applicant also respectfully submits that it was not well known in the art at the time of the invention to determine that a print job requires printing device capabilities not compatible with the printing device and to emulate the capabilities after receiving a request at the printing device to despool the print job to the printing device as is recited in claim 36. Finally, Applicant also respectfully submits that it was also not well known in the art to emulate such capabilities as copy collation, booklet printing, or N-up printing in response to such a request.

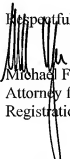
As all independent and dependent claims recite one or more of such limitations that are not taught by any of the cited references, either alone or in combination, and as such limitations were not well known in the art at the time of the invention, none of the claims in the claim set provided herein is made obvious by the cited references. Applicant therefore respectfully requests removal of all rejections under 35 U.S.C. § 103(a).

CONCLUSION

Applicant submits that the amendments made herein do not add new matter and that the claims are now in condition for allowance. Accordingly, Applicant requests favorable reconsideration. If the Examiner has any questions or concerns regarding this communication, the Examiner is invited to call the undersigned.

DATED this 3 day of July, 2008.

Respectfully submitted,


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